

REMARKS

Claims 1, 8, 18, 23 and 24 have been amended. Claims 1-24 are pending in the application. Reconsideration and allowance of the claims in light of the present remarks is respectfully requested.

Discussion of Claim Rejections Under 35 U.S.C. § 101 of Claims 1-24

Claims 1-24 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter as not falling within one of the four statutory categories of inventions. The Examiner states "[w]hile the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, there is no apparatus mentioned either in the preamble nor in the subsequent limitations for executing the method, nor is key frame determination considered a transformation of the signal." Applicant has amended independent Claims 1, 8, 18, 23 and 24 to provide the sufficient tie to a particular machine or apparatus. Accordingly, independent Claims 1, 8, 18, 23 and 24, and their dependent claims, are directed to statutory subject matter under 35 U.S.C. § 101. Therefore, Applicant respectfully requests the rejection to be withdrawn.

Discussion of Claim Rejections Under 35 U.S.C. § 102(e) of Claims 1-24

Claims 1-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Normille et al, U.S. Patent No. 5,267,334. Applicant respectfully submits that, as stated in the M.P.E.P. at § 2131, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987). Further, the elements must be "arranged and combined as required by the claim." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359 (Fed. Cir. 2008).

Applicant's Claim 1 recites in part: "providing a reference frame; providing, via a processor, a current frame different from the reference frame; identifying, via the processor, the current frame as a key frame if ..., otherwise selecting a new current frame; and repeating ... until a key frame is identified." Independent Claims 8, 18, 23 and 24 have similar features. A

current frame is compared to a reference frame and the reference frame stays fixed until the key frame is identified. In contrast, Normille determines a difference between successive frames. Normille teaches at column 15, lines 35-37: "Scene detector block 815 automatically detects the difference in the energy of chrominance between successive frames." See also column 15, line 59 and column 16, lines 7-8. Since Normille does not disclose all claim features, Applicant respectfully submits that Claims 1, 8, 18, 23 and 24 are patentable over Normille.

Additionally, Claim 1 recites in part: "determining a structure difference measure between the reference frame and the current frame based, at least in part, on edges identified in each of the frames". Independent Claims 18, 23 and 24 recite similar features. Claim 8 recites in part: "determining a second difference measure between the reference frame and the current frame based, at least in part, on edges identified in each of the frames". The Examiner identified a portion of Normille at column 15, lines 1-10 that describes forward and backward pointers, but not a structure difference measure between the frames. According to column 15, lines 2-4 and Figure 7b, the forward pointer 752 is a 16 bit field and backward pointer 753 is a 16 bit field, and "[t]hese fields merely provide linkage information for forward and reverse play." There is no discussion here of structures in the frames in Normille. The citation of Normille, column 22, lines 23-35 for Claim 18 appears to be in error since lines 23-25 describe a chrominance difference energy determination means which does not teach determining a structure difference measure. Applicant respectfully submits that Normille does not teach all claim features, and that therefore, Claims 1, 8, 18, 23 and 24 are patentable over Normille.

Moreover, Claim 1 recites in part: "identifying, via a processor, the current frame as a key frame if the chromatic difference measure exceeds a chromatic threshold and the structure difference measure exceeds a structure threshold", and similarly for Claim 23 and 24. Claim 8 recites in part: "identifying, via a processor, the current frame as a key frame if the first difference measure exceeds a first threshold and the second difference measure exceeds a second threshold, otherwise selecting a new current frame". The Examiner has cited Normille at column 15, lines 40-55 to try to teach this feature. However, the cited passage discusses reverse playback and the lack of motion compensation in reverse playback. The cited portion of Normille does not describe both a chromatic threshold and a structure threshold and also exceeding both thresholds to identify the

current frame as a key frame. Applicant respectfully submits that Normille does not teach all claim features, and that therefore, Claims 1, 8, 23 and 24 are patentable over Normille.

Dependent Claims

Applicant's Claim 5 (and similarly Claim 21) recites: "wherein the predetermined time interval is user-selectable". The Examiner has identified column 16, lines 30-40 of Normille as teaching this feature. However, the cited passage describes that user interaction indicates whether forward or reverse play of the video is to take place, and not that the predetermined time interval is user-selectable.

Applicant's Claim 6 (and similarly Claim 13 and 22) recites: "wherein the value of the chromatic threshold and the value of the structure threshold are each user-selectable". The Examiner has identified column 16, lines 1-5 and 33-38 of Normille as teaching this feature. However, the cited passage describes that user interaction indicates whether forward or reverse play of the video is to take place, and not that the value of the chromatic threshold and the value of the structure threshold are each user-selectable.

Although Applicant has not addressed all the issues of the dependent claims, Applicant respectfully submits that Applicant does not necessarily agree with the characterization and assessments of the dependent claims made by the Examiner, and Applicant believes that each claim is patentable on its own merits. The dependent claims are dependent either directly or indirectly on one of the above-discussed independent claims. Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompt allowance of the claims.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this

application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Conclusion

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections are specifically requested. The undersigned has made a good faith effort to respond to all of the noted rejections and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if an issue requires clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve any such issue promptly.

Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art discloses or teaches, even if not expressly discussed herein. Although changes to the claims have been made, no acquiescence or estoppel is or should be implied thereby; such amendments are made only to expedite prosecution of the present application and are without prejudice to the presentation or assertion, in the future, of claims relating to the same or similar subject matter.

Any remarks in support of patentability of one claim should not be imputed to any other claim in this or a related application, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on solely that portion; rather, patentability must rest on each claim taken as a whole. Applicant has not presented all arguments concerning whether the applied references can be properly combined in view of the clearly missing elements noted above, and Applicant reserves the right to later contest whether a proper reason exists to combine these references.


Application No.: 08/870836
Filing Date: June 6, 1997

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 12, 2011

By: 
Raimond J. Salenieks
Registration No. 37,924
Agent of Record
Customer No. 20995
(858) 707-4000

11559235
071111